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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,866

Applicant(s)

BENNETT ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4,6-8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The use of various trademark(s), for example "iShip.com", "iShip", "The Internet Package shipper", "Price It", "Sell It", "Track It", "Ship It", "Track It", "Ship It", "Shipping Tools", "My iShip", "Netscape's Navigator™", "Microsoft Internet Explorer™", in the paragraph:

A) at pages 11, lines 10-13, "iShip.com", "iShip", "The Internet Package shipper", "Price It", "Sell It", "Track It", "Ship It", "Track It", "Ship It", "Shipping Tools", "My iShip" and ...of their respective owners.";

B) at page 15, lines 3-8, "Users access 1003 ... web browsers include, e.g. Netscape's Navigator™ and Microsoft Internet Explorer™."; and

C) between page 15, lines 10-13, "As depicted in FIG. 5, using ... "iShip.com" ...particular Carrier's web server.";

have been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) it is noted that as depicted and disclosed a number of figures are in fact separately depicted sections/parts of a single figure spread out over a number of sheets of drawings, that is:

(a) figs. 10a, 10b, 10c, 10d & 10e form a single figure;

- (b) figs. 27a, 27b & 27c form a single figure;
- (c) figs. 33a & 33b form a single figure;
- (d) figs. 36c & 36d form a single figure;
- (e) figs. 37a & 37b form a single figure;
- (f) figs. 39a, 39b & 39c form a single figure;
- (g) figs. 64a-1 & 64a-2 form a single figure;
- (h) figs. 64b-1 & 64b-2 form a single figure; and
- (i) figs. 65a & 65b form a single figure.

Therefore, pursuant to 37 CFR § 1.84(u)(1) each of:

- (a) figs. 10a, 10b, 10c, 10d & 10e should be labeled as -10A--, -10B--, --10C--, --10D-- & -10E--, respectively;
- (b) figs. 27a, 27b & 27c should be labeled as -27A--, --27B--, and -27C--, respectively;
- (c) figs. 33a & 33b should be labeled as -33A-- & --33B--, respectively;
- (d) figs. 36c & 36d should be labeled as --36C-- & --36D--, respectively;
- (e) figs. 37a & 37b should be labeled as -37A-- & --37B--, respectively;
- (f) figs. 39a, 39b & 39c should be labeled as -39A--, --39B--, & -39C--, respectively;
- (g) figs. 64a-1 & 64a-2 should be labeled as -64A-1-- & --64A-2--, respectively;
- (h) figs. 64b-1 & 64b-2 should be labeled as --64B-1-- & --64B-2--, respectively; and
- (i) figs. 65a & 65b should be labeled as -65A-- & --65B--, respectively.

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) 1071 of fig. 36a as disclosed in the paragraph at page 45, lines 11-18, "At the intersection ... element 1071 ... for which that cell represents the intersection."

(3) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

(a) note below in section (4)(B)(1) of the objection to the disclosure.

(4) as can be seen in fig. 54 and from the context of the paragraph at page 73, lines 19-25, "In creating the display ... browser 258 display device DPI is 96.", it appears from the text contained in box 1256 that either the "YES" and "NO" legends or reference numbers 1257 & 1257 are reversed.

3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

4. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data on page 1,
with the current status of each of the referenced applications, e.g., --now abandoned--,
or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 9n, 11n, 12n, 13n, 21a, 1003a, 1003b, 1003c, 1003d, 1024n & 1027n of fig. 7 as this figure is being described in the paragraphs between page 17, line 10, and page 18, line 22, "FIG. 7 is a simplified ... which is described in detail below.";

(b) 122, 123a, 123b & 124 of fig. 13 as this figure is described in the paragraph at page 23, lines 4-15, "If the data entered ... below with regard to FIG. 26.";

(c) 42 of fig. 10A as this figure is described in the paragraphs between page 21, line 7, and page 24, line 19, "FIGS 10a through 10e ... setup selling preferences for eCommerce transactions.";

(d) 80 of fig. 10c as this figure is described in the paragraphs between page 43, line 13, and page 44, line 14, "As depicted in FIG. 34, ... as depicted in FIG. 10c).";

(e) 62 & 80 of fig. 10d as this figure is being described (note the objection to the references and labeling of figs. 10a-10e, above and below);

(f) 80 of fig. 10e as this figure is being described (note the objection to the references and labeling of figs. 10a-10e, above and below);

(g) 163a, 163b, 163c, 163d, 163e, 165a, 165b, 165c, 165d, 165e, 165f, 165g, 167a & 167b of fig. 19 as this figure is described between page 25, lines 6-15, "FIG. 19 is a ... the selection button e.g., 160.";

(h) 178 of fig. 21 as this figure is described in the paragraphs between page 25, line 19, and page 26, line 7, "If the User clicks the Next button 102 ... User so that the User can process the information 180.";

(i) 238 of fig. 23 as this fig. is described in the paragraph at page 27, lines 1-14, "As depicted in FIG. 23 ... preferences have been saved 239.";

(j) 31b-4 of fig. 24 as this figure is described in the paragraph between page 27, line 28 and page 28, line 9, "Fig. 24 is a ... of a Create a Seller's Link Screen 52.";

(k) 204 of fig. 25 as this figure is described at page 28, lines 5-13, "Once the User has completed ... is asked to enter the Shipping Weight 191a.";

(l) 612 of fig. 27a as this figure is described in the paragraphs between page 30, line 25, and page 33, line 13, "In order to identify ... that the weight is not stable 624.";

(m) 1032-1, 1032-2, 1032-3, 1032-4, 1032-5, 1032-6, 1032-7, 1077, 1078, 1101a, 1101b, 1140, 1141, 1142 & 1142a of fig. 28 as this figure is being described in the paragraphs between page 34, line 14, and page 38, line 19, FIG. 28 depicts ... as described above with regard to FIGS. 15 and 26).";

(n) 216 & 217 of fig. 30 as this figure is described in the paragraphs between page 38, line 28, and page 40, line 11, "FIG. 30 depicts ... Seller's eCommerce/eAuction item description.";

(o) 214 of figs. 31 & 32 as these figures are described in the paragraphs between page 39, line 23, and page 41, line 18, "In order to create ... PID and its associated set of information.";

(p) 251-2, 251-4, 252-1, 252-2, 252-3, 252-4, 253-1, 253-2, 253-4, 255-1, 255-2, 255-3, 255-4, 256-1, 256-3, 257-2, 257-3, 257-4, 257-5, 257-6, 257-7, 258-2, 258-3, 258-4, 270-1, 270-2 & 270-3 of figs. 33a & 33b as these figures are described in the paragraphs between page 41, line 19, and page 42, line 29, "FIGS. 33a and 33b ... Account User Configuration table 253.";

(q) 1140, 1141, 1142, 1143 of fig. 36a as this figure is described in the paragraphs between page 44, line 20, and page 51, line 9, "FIG. 36a depicts an ... the Shipping Location field 1066.";

(r) 1152 of fig. 39a as this figure is described in the paragraph at page 59, lines 14-18, "In the embodiment depicted ... further Shipper Parcel Specifications 1150.";

(s) 1192 of fig. 39c as this figure is described in the paragraphs between page 62, line 1, and page 63, line 12, "Next 1179, the system ... in the delivery rate set 1157.";

(t) 359 of fig. 42 as this figure is described in the paragraphs between page 66, line 17, and page 67, line 3, "FIG. 42 is a ... Tracking section of the disclosure of the present invention.";

(u) 373 of fig. 43 as this figure is described in the paragraphs at page 67, lines 4-19, "FIG. 43 is a ...10d) in the Buyer Response process.";

(v) 431-1 of fig. 47 as this figure is being described in the paragraph at page 70, lines 10-23, "In an eCommerce embodiment ... 418 to send the payment information to processing.";

(w) 1111 of fig. 48 as this figure is described in the paragraph between page 70, line 24, and page 71, line 8, "In an exemplary simplified Internet ... Expiration Date, and Credit Card Type.";

(x) 426 of fig 51 as this figure is described in the paragraph between page 71, line 22, and page 72, line 2, "In an exemplary eCommerce ... shipped by the particular Shipper/Seller.";

(y) 32b-4, 32b-5, 32b-6 & 32b-7 of fig. 50 as this figure is described in the paragraph at page 72, lines 3-13, "The Seller can view ... shipment 445, or reprint a label 446.";

(z) 1258 of fig. 54 as this figure is described in the paragraph at page 73, lines 19-26, "In creating the display ... browser 258 display device DPI is 96.";

(aa) 2050 & 2051 of fig. 69 as this figure is described in the paragraphs between page 83, line 26, and page 86, line 3, "FIG. 69 is a logic flow ... as described above regarding Package Table 28 records.";

(ab) 2081, 2090 & 2097 of fig. 72 as this figure is described in the paragraphs between page 87, line 9, and page 93, line 1, "As depicted in FIG. 72, if ... for the packages that are shipped using the CMS.";

(ac) 2101 of fig. 73 as this figure is described in the paragraph at page 93, lines 2-5, "FIG 73 is a graphic ... clicking on the "Track" button 2102.";

(ad) 2120 & 2123 of fig. 77 as this figure is described in the paragraphs between page 93, line 26, and page 94, line 22, "FIG. 77 is a graphic ... record in the list and clicks the "Details" button 2124.";

(ae) 2164 & 2166 of fig. 80 as this figure is described in the paragraph at page 95, lines 9-20, "A registered logged on User ... for that User on Inbound Packages to be monitored."; and

(af) 2123 of fig. 81 as this figure is described in the paragraph between page 95, line 21, and page 96, line 5, "Once the User has input ... line on the screen and clicking the "Delete" button 2170."; and

(2) how the program proceeds after box(es):

(a) 620 of fig. 27B if the inquiry is "NO" in the paragraphs between page 30, line 25, and page 33, line 13, "In order to identify ... that the weight is not stable 624.";

(b) 3026 of fig. 36c as this figure is described in the paragraph at page 55, lines 13-27, "As depicted in Figures 36c through 36d, ... to different parties for various billing options).";

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(c) 3042 & 344 of fig. 36e if the inquiry is either "YES" or "NO" as this figure is described in the paragraph between page 55, line 28, and page 56, line 7, "As depicted in FIG. 36e ... to a particular Carrier/Service 3044.";

(d) 1163, 1168, 1169, 1172 & 1175 of fig. 39b if the inquiry is "NO" as this figure is described in the paragraphs between page 60, line 11, and page 66, line 6, "Using the Expected Shipping Date ... Carrier/Service in the delivery rate set 1157.";

(e) 1180, 1184, 1187 & 1190 of fig. 36c if the inquiry is "NO" as this figure is described in the paragraphs between page 62, line 1, and page 63, line 12, "Next 1179, the system ... in the delivery rate set 1157.";

(f) 1192 of fig. 36c if the inquiry is either "YES" or "NO" as this figure is described in the paragraphs between page 62, line 1, and page 63, line 12, "Next 1179, the system ... in the delivery rate set 1157."; and

(g) 2050 of fig. 69 if the inquiry is "Fail" as this figure is described in the paragraphs between page 83, line 26, and page 86, line 3, "FIG. 69 is a logic flow ... as described above regarding Package Table 28 records.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) in the paragraph oat page 1, lines 24-26, "Each parcel ... parcel weight, parcel value, parcel value and the like.", the phrase "parcel value is used twice.

(2) in regard to the labeling of the drawings as required above in section (3)(A)(1), it is noted that the references in the disclosure to the drawings must be consistent as required by 37 CFR § 1.121(e), therefore with in the specification, pursuant to 37 CFR § 1.84(u)(1) and 37 CFR § 1.121(e) each of the references to:

(a) figs. 10a, 10b, 10c, 10d & 10e should be -10A--, -10B--, --10C--, --10D-- & -10E--, respectively;

(b) figs. 27a, 27b & 27c should be -27A--, --27B--, and -27C--, respectively;

(c) figs. 33a & 33b should be -33A-- & --33B--, respectively;

(d) figs. 36c & 36d should be --36C-- & --36D--, respectively;

(e) figs. 37a & 37b should be -37A-- & --37B--, respectively;

(f) figs. 39a, 39b & 39c should be -39A--, --39B--, & -39C--, respectively;

(g) figs. 64a-1 & 64a-2 should be -64A-1-- & --64A-2--, respectively,

(h) figs. 64b-1 & 64b-2 should be --64B-1-- & --64B-2--, respectively; and

(i) figs. 65a & 65b should be -65A-- & --65B--, respectively.

In this regard it is noted that the above figs. have been mentioned in the disclosure with in the paragraphs located:

(a) between page 3, line 30, and page 4, line 2, "FIGS 10a through 10e are high ... system eCommerce environment;";

(b) at page 5, lines 19-21, "FIGS 27a through 27c are high ... System in an Internet environment;";

(c) at page 6, lines 7-10, "FIGS 33a and 33b represent ... system eCommerce environment;";

(d) at page 6, lines 21-22, "FIGS 36b through 36e are high ... system uses to calculate a shipping rate;";

(e) at page 6, lines 26-29, "FIGS 37a and 37b represent ... system eCommerce environment;"

(f) at page 7, lines 3-6, "FIGS 39a through 39c are high ... System in an Internet environment;"

(g) at page 9, lines 11-14, "FIGS. 64a-1, 64a-2, 64b-1 and 64b-2 are ... system eCommerce environment.";

(h) at page 9, lines 15-18, "FIGS. 65a and 65b represent ... system eCommerce environment.";

(i) page 11, lines 2-9, "A portion of the disclosure ... FIGS 10a through 10e, ... reserves all copyright whatsoever.";

(j) between page 21, line 7, and page 28, line 9, "FIGS 10a through 10e ... a Create a Seller's Link Screen 52.";

(k) between page 30, line 25, and page 33, line 13, "In order to identify ... that the weight is not stable 624.";

(l) page 41, lines 19-28, "FIGS. 33a and 33b ... Site table 260, and Site table 270.";

(m) between page 43, line 13, and page 44, line 14, "As depicted in FIG. 34, ... as depicted in FIG. 10c).";

(n) between page 54, line 20, and page 56, line 7, "FIGS 36b through 36e ... to the particular Carrier/Service 3044.";

(o) between page 56, line 8, and page 57, line 12, "In an eCommerce embodiment ... on the display monitor of the Buyer's computer 8-2.";

(p) at page 57, lines 13-19, "Whether or not the Buyer/Seller ... the purchase and shipping of the item.";

(q) between page 58, line 25, and page 64, line 2, "FIGS 39a through 39C are ... are performed by one or more of the NOC Servers 20a-21z.";

(r) at page 65, lines 10-14, "It should be noted that, ... relation to FIGS 39a through 39c.";

(s) between page 65, line 27, and page 67, line 28, "FIG. 41 is a ... Buyer Shipping Information Collection screen (61, FIG. 10d).";

(t) at page 70, lines 1-9, "Once the Shipper selects ... and information for the Selected Carrier.";

(u) between page 70, line 10, and page 72, line 24, "In an eCommerce embodiment ... the Seller and as finally selected by the Buyer.";

(v) between page 76, line 24, and page 77, line 22, "Returning to the exemplary ... can be delivered via the carrier (74, FIG. 10e).";

(w) between page 78, line 3, and page 79, line 21, "FIGS. 64a-1, 64a-2, 64b-1 and 64b-2 ... displays the Shipping screen to the Seller 530."; and

(x) between page 79, line 22, and page 80, line 7, "FIGS 65a and 65b represent a ... Bill contact name 26-15, and Bill address 1 261-16.".

(3) as can be seen in fig. 27a and from the context of the paragraph between page 31, line 25, and page 32, line 3, "Continuing with FIGS 27a through 27c, ... interface 613. Otherwise, the user may input the weight 613 in the Weight field 1051 as depicted in e.g., FIG. 26.", at line 7 of this paragraph "weight 613" should be -weight 612--.

(4) as can be seen in fig. 28 and from the context of the disclosure at page 36, lines 20-25, "Sorted, valid delivery times ... buttons 1100a and 1100b respectively. If an up or down button (1100a and 1100b respectively) ... Array display area 1096.", at lines 2 & 3 of this paragraph "1100a and 1100b" should be -1101a and 1101b--.

(5) the description of figs. 33a & 33b in the paragraphs between page 41, line 19, and page 42, line 29, "FIGS. 33a and 33b ... Account User Configuration table 253.", does not correspond to what is depicted in these figs.

(6) the description of figs. 36c & 36d in the paragraph at page 55, lines 13-27, "As depicted in Figures 36c through 36d, ... to different parties for various billing options).", does not correspond to what is depicted in these figs. in regard to step 3026, since at one point the "YES" and "NO" legends appear to be mislabeled, note lines 2-3 of this paragraph and lines 8-10 of this paragraph.

(7) as can be seen in fig. 39a, and from the context of the paragraph at page 59, lines 14-18, "In the embodiment depicted ... messages 153 ... further Shipper Parcel Specifications 1150.", at line 5 of this paragraph "153" should be -1153--.

(8) as can be seen in fig. 54 and from the context of the paragraph at page 73, lines 19-25, "In creating the display ... browser 258 display device DPI is 96.", at line 7 of this paragraph "258" should be -1258--.

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claim 45 is are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 The subject matter of claim 45 lacks antecedent basis in claim 43. It is noted that maybe claim 45 should depend from claim 44.

6.2 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. Claims 1-53 are provisionally rejected under the judicially created doctrine of double patenting over:

A) claims 1-72 of copending Application No. 09/680,649; or

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- B) claims 1-89 of copending Application No. 09/680,654; or
- C) claims 1-6 of copending Application No. 09/684,014; or
- D) claims 1-9 of copending Application No. 09/684,861; or
- E) claims 1-21 of copending Application No. 09/684,865; or
- F) claims 1-63 of copending Application No. 09/684,869; or
- G) claims 1-31 of copending Application No. 09/684,010; or
- H) claims 1-57 of copending Application No. 09/685,077; or
- I) claims 1-58 of copending Application No. 09/685,078.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

7.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- A) in a computer network system comprising a central computer/server connected to a number of user/client computers and configured/programmed to provide various interactive shipping services, such as rating, rate comparison and tracking for multiple carriers to the users in response to the requests of users sent to the server from the client computers via the network.

It is noted that the information, whether it is shipping rate data, rate comparison data, tracking data, etc. or how the requested information is displayed to the user does not affect the operation of the basic system as recited in each of the identified application, hence the type of information/data is considered to be non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

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- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 3, 44 & 45 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

8.1.1 The instant claims recite a system/device, (claims 3, 44 & 45), which has a practical application in the technological arts, and which does not merely define either a computer

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program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a series of steps that could be but are not necessarily to be performed on a computer.

8.1.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 3, 44 & 45 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

8.1.3 In view of the above, the invention recited in claims 3, 44 & 45, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 3, 44 & 45 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

8.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

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- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

8.1.5 Hence, claims 3, 44 & 45 are directed to non-statutory subject matter.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.1 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258).

9.2 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by PRNewswire release from Tempe Arizona (herein after TEMPE).

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9.3 Claims 1-5, 11-34, 36-47, 49 & 50 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Barton (2002/0022983).

9.4 In regard to claims 1-5, 11-34, 36-47, 49 & 50, either TULSA or Thiel ('258) or TEMPE or Barton ('983) discloses a computerized shipping system that comprises cooperation among a number of properly programmed server and client systems. When these systems cooperate, the shipping systems accept rating related information, for example, size, weight, destination, special services, etc., from users and then return to the user from the server the shipping rate for a number of different carriers using a communications network to exchange the information. The determined rate for each of the carriers, that will support the specification in the user's request, is then provided/displayed to the user in a convenient format so that the user may select the carrier that best suites the needs of the user.

9.4.1 Where the shipping system of either TULSA or TEMPE or Barton ('983) is an internet based shipping system.

9.4.2 And where the shipping systems of either TULSA or Thiel ('258) permits the user track the item being shipped for it's origin to it's destination. Since, this tracking feature would inherently indicate the fact that the recipient has either accepted or refused delivery of the shipped item, and if the shipped item was purchased and the recipient refused to accept delivery, then such an occurrence indicate that recipient has refused to complete the purchase of the item being shipped.

9.4.3 Further, since:

A) the internet is a communications network as is the wireless network of Thiel ('258), and

B) the claims fail to recite sufficient structure so at to distinguish a particular type of communications network,

one of ordinary skill at the time the invention would recognize the two separate types of networks as functionally equivalent. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention

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from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- (c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10.1 Claims 6-8 & 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-5, 11-34, 36-47, 49 & 50 and further in view of an obvious modification for customer service.

10.1.1 In regard to the use of user preferences of claims 6-8 & 48, although neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose using user preferences, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping

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systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could be modified to record the user's preferences for shipping services, since it would be good customer service to not require a frequent user to constant re-enter shipping/payment information each time the user used the shipping system.

10.2 Claims 35 & 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8, 11-34 & 36-50 and further in view of an obvious modification in view of the need of the customer.

10.2.1 In regard to claims 35 & 51 neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose comparing the delivery times a number of carriers. However, it is respectfully noted that:

A) the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) may be more concerned with when the package may arrive at it's destination due to some time related requirements rather than spending the least amount of money to have the package shipped; and

B) most carriers offer over night or next day or two days services.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the user of the systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could also considered the delivery times when selecting a carrier.

10.3 Claims 52 & 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or Thiel (5,699,258) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8 & 11-51 and further in view of an obvious modification in view of the need of the customer.

10.3.1 In regard to the printing of a shipping label of claims 52 & 53, although neither TULSA nor Thiel ('258) nor TEMPE nor Barton ('983) disclose using printing a shipping label, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either TULSA or Thiel ('258) or TEMPE or Barton ('983) could

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be modified to print shipping labels, since most carriers require the user to pre-address the item before the carrier accepts the item for shipping.

10.4 Claims 9 & 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either PRNewswire release from Tulsa Oklahoma (herein after TULSA) or PRNewswire release from Tempe Arizona (herein after TEMPE) or Barton (2002/0022983) as applied to claims 1-8 & 11-53 and further in view of an obvious modification in view of the system's operation.

10.4.1 In regard to the linking of claims 9 & 10, although neither TULSA nor TEMPE nor Barton ('983) disclose using hyperlinks, it would have been obvious to one of ordinary skill at the time the invention was made that the internet based shipping systems of either TULSA or TEMPE or Barton ('983) would use hyper links to permit the user to move from one location to another location or from one web page to another as is common in internet based systems.

11. In regard to the Information Disclosure Statements filed December 10, 2001 and December 18, 2001, it is noted that the appendix of application serial number 09/820,377 as well as the 15 U.S. Patent Applications listed were not publicly known before the filing date of the instant application, that is October 06, 2000, therefore these applications have been considered only for the purposes of double patenting.

12. The examiner has cited prior art of interest, for example:

A) Uchimura et al (4,351,033) discloses reusing previous entered data concerning a shipment so that the user does not have to repeatedly reenter the same data.

B) either Picione (4,495,581) or Barns-Slavin et al (5,117,364) or Solondz et al (5,602,742) disclose rating an item to be shipped for number of different classes and carriers based on user input values in order to determine the lowest shipping rate.

C) Nomura (JP 05-276353) discloses charging the end user for service provided over a network.

D) either the IBM Technical Disclosure Bulletin or Denter (5,724,595) or Knowles et al (5,869,819) disclose that information is acceded over the internet by using links to other web sites and/or documents/information that are contained within a

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web page/document or an internet address. Further, Knowles et al ('819) is an internet based shipping system.

C) either Levitsky et al (6,466,948) or Carroll et al (6,470,327) disclose rating an item to be shipped for number of different classes and carriers based on user input values.

13. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

14.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

14.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

14.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/05/04



Edward R. Cosimano
Primary Examiner A.U. 3629